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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			MACNEILL, ELIZABETH	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/634,656

Filing Date: August 05, 2003

Appellant(s): DUNN ET AL.

Schwegman, Lundberg, Woessner & Kluth, P.A.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 November 2005 appealing from the Office action mailed 06 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,629,455	KANNO	12-1986
4,743,229	CHU	05-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,743,229 to Chu in view of U.S. Patent No. 4,629,455 to Kanno.

In reference to claim 1, Chu discloses a coupling syringe system having a first syringe 12 including a first syringe barrel 16 having a first syringe open proximal end 20, a first syringe distal end 18, a first syringe tip with a male end portion (unnumbered), locking ring 42, tip (unnumbered), a first syringe inner surface 56, a first syringe plunger 40, a second syringe 14, a second syringe barrel 22, a second syringe open proximal end

26, a second syringe distal end 24, second syringe tip 50 with a female end portion (unnumbered), exteriorly protruding members 52 adapted to detachably fit the locking ring 42, a second syringe inner surface 58, and a second syringe plunger 32, where the female end portion has an opening therein (unnumbered) that is configured and sized to receive the tip of the male end portion therein, where the locking ring couples the first syringe to the second syringe when the male end portion is disposed within the female end portion, forming a fluid tight engagement. See Figures 1-3.

In reference to claim 2, the female end portion has at least one exteriorly protruding members that are adapted to detachably engage the locking ring.

In reference to claims 3 and 4, the locking ring is configured to detachably connect to a discharge assembly. The locking ring is a standard Luer connector, which can connect to various types of needles. See col. 4, lines 44-59.

In reference to claims 5 and 6, the female end portion of the second syringe is detachably connected to the male end portion of the first syringe and can be detached from it.

In reference to claim 7, Chu discloses an outwardly projecting flange (unnumbered) near the first syringe proximal end.

In reference to claim 8, Chu discloses an outwardly projecting flange (unnumbered) near the second syringe proximal end.

In reference to claim 10, the locking ring is threadingly coupled with one or more projections disposed on an outer surface of the female end portion. See col. 4, lines 44-54.

In reference to claim 11, the male end is disposed within the female end. See Figures 1 and 3.

In reference to claims 13 and 14, the first syringe contains a drug delivery system 28 and the second syringe contains a drug 30.

In reference to claims 9 and 12, Chu discloses the claimed invention as shown above. Chu, however, does not disclose that the locking ring 42 is rotatably coupled to the male end portion of the first syringe. Kanno discloses a connector system having a male end portion 12 adapted to be inserted into the female end portion 13 where the locking ring 17 is rotatably coupled to the male end portion. See Figure 3. Kanno discloses the disadvantages of having a locking ring that is monolithically formed to the male end portion. See Figure 1 and col. 1, lines 19-38. Chu does not teach against such a connection. It would have been obvious to one of ordinary skill in the art to modify the invention of Chu by having the locking ring rotatably coupled to the male end portion, as suggested by Kanno, in order to provide a connection assembly that is reliable and prevents drug loss due to a faulty connection thereby resulting in a mixture that may not be properly combined.

(10) Response to Argument

a. Chu teaches every element that is recited in Applicant's claim 1.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the connection means integrated with either the first syringe or second syringe [Appeal Brief, p. 14, lines 15-20]; the connection between the first and second syringes

does not result in significant loss of composition [Appeal Brief, p. 17, lines 1-13]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b. There is suggestion to modify or combine the cited references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is clear teaching, suggestion, or motivation to modify the device taught by Chu with the teachings of Kanno in the knowledge generally available to one of ordinary skill in the art. The motivation is to provide a male and female connection alternative that can be joined firmly with high reliability. Although Chu does not explicitly teach such a modification, Chu does not teach against it. Additionally, the modification will not destroy the functionality of Chu's male-female connection. Applicant asserts that the motivation provided by the Examiner amounts to a generalization that must be supported by Official Notice. Such Official Notice is not necessary since such motivation can be found in Kanno (col. 1, lines 19-38).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Elizah MacNeil for Mark Han
Mark Han
Patent Examiner
Art Unit 3767
2/7/07

Conferees:

Angela Sykes
Kevin Sirmons

Angela D. Sykes

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Kevin C. Sirmons
KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER